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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/459,171 12/10/99 ROMANCZYK L 5677-085

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HM22/1228

EXAMINER

SOLOLA, T

ART UNIT	PAPER NUMBER
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1626

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DATE MAILED: 12/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/459,171

Applicant(s)
Romanczyk et al.

Examiner
Taofiq A. Solola

Group Art Unit
1626



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-33 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17, 20, 21, and 33 is/are rejected.
- ☒ Claim(s) 18, 19, and 22-32 is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1626

Claims 1-33 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-21 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phraseologies “preventing diseases caused by chronic inflammation,” line 1, claim 20, and “preventing vascular diseases,” line 1, claim 21, are not defined in the specification so as to determine the diseases that are embraced by the phraseologies. The claims are drawn to methods of preventing diseases. However, not all vascular diseases or diseases caused by chronic inflammation are preventable. Therefore, the specific diseases must be disclosed in the specification so as ^{to} enable the Examiner to determine if such diseases are in fact preventable. By including a list of the specific diseases the rejection would be overcome. However, applicants should note that the introduction of new subject matter into the specification will raise the issue of new matter.

Art Unit: 1626

The term “product” line 1, claim 33, is not defined in the specification so as to determine what applicants are claiming.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 20-21 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phraseologies “preventing diseases caused by chronic inflammation,” line 1, claim 20, and “preventing vascular diseases,” line 1, claim 21, are not defined in the claims so as to determine the diseases that are embraced by the phraseologies. Therefore, the claim are indefinite. The claims are drawn to methods of preventing diseases. However, not all vascular diseases or diseases caused by chronic inflammation are preventable. Therefore, the specific diseases must be listed in the claims so as enable the Examiner to determine if such diseases are in fact preventable. By including a list of the specific diseases the rejection would be overcome. Applicants are reminded that a claim must stand alone to define the invention, and incorporation into the claim by express reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). See the Examiner’s suggestion above.

Art Unit: 1626

Claim 5 recites on lines 1-3, "procyanidins are present in cocoa extract, chocolate liquor, . . . cocoa nibs fractions, or mixture thereof." The claim is confusing and therefore claims 5-14 are indefinite. There is no relationship between the extracts and the claimed composition. The fact that procyanidin is present in the extracts does not necessarily mean it is present in the composition as written. By replacing "present" with "obtained from" the rejection would be overcome.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Clapperton et al., "Polyphenols and Cocoa Flavour", presented at the XVIth Internat. Conference of the Groupe Polyphenols, Lisbon, Portugal, vol. 16, 1992.

Clapperton et al., disclose composition comprising polyphenol (procyanidins) from cocoa. See the summary, page 1, paragraph 2. The procyanidins are in monomers and oligomers (table 1). The compositions are made into liquor (page 2, paragraph 4, line 2). Therefore, the Examiner assumed the solvent is water, methanol, ethanol, acetone, ethyl acetate, or a mixture thereof, absent a showing to the contrary.

Art Unit: 1626

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 and 12-14 of prior U.S. Patent No. 5,555,465. This is a double patenting rejection.

Allowable Subject Matter

Claims 18-19 and 22-32 are objected to as being dependent upon a rejected base claim, but may be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

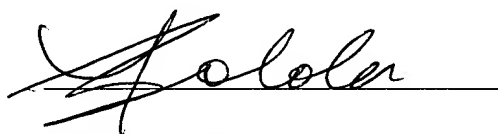
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola whose telephone number is (703) 308-4690.

Art Unit: 1626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "Taofiq A. Solola", is written over a horizontal line.

Taofiq A. Solola

Patent Examiner

Group 1626

December 27, 2000